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09/823,218	03/29/2001	Richard W. Kay	8030-2	6072

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EXAMINER

VU, NGOC K

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/823,218

**Applicant(s)**

KAY ET AL.

**Examiner**

Ngoc K. Vu

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-86 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-86 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/15/04, 11/19/02</u> . | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-12, 19, 20, 24, 27, 28, 32-37, 43, 44, 47, 49-51, and 55-86 are rejected under 35 U.S.C. 102(b) as being anticipated by Budow et al. (US 5,521,631 A).

Regarding claim 1, Budow discloses a system for delivering digital content on demand in a multiple unit environment, the system comprising:

a server (12) local to the multiple unit environment (hospitality establishments), the server including a memory storing the digital content and capable of supporting multiple simultaneous asynchronous accesses to the digital content (the video server 12 is used to store digitized video programming for video on demand that are simultaneously accessible to hundreds of viewers) (see col. 6, lines 51-66; col. 9, lines 4-12, 39-42 and 54-57);

a billing system (13) for billing each individual unit based on use of the digital content (the systems control computer 13 processes billing information), the billing system coupled to the server (see col. 8, lines 4-12; col. 12, lines 7-13); and

at least one access system (15) in a plurality of units in the multiple unit environment, the access system designed to access the digital content stored in the memory on the server (e.g., the terminal 15 is used to control reception of the pay per view or video on demand programming - see col. 7, lines 24-50).

Regarding claim 34, Budow discloses a method for delivering digital content, the method comprising:

receiving a request for the digital content from a unit in a multiple unit environment at a server (receiving a request for digital content such as video on demand programming requested from one of room terminals 15 at server 12 via the system computer 13 – see col. 9, line 65 to col. 10, lines 1; col. 10, lines 59-62);

accessing the digital content from a memory on the server; and delivering the digital content to the unit (the video sever 12 receives commands from the system control computer 13, which instructs the server 12 regarding which programming to play and which room terminals are to receive the programming. It is noted that the video server 12 comprises storage such as a plurality of video disk drives to store video – see col. 9, lines 7-12; col. 9, line 65 to col. 10, lines 1; col. 10, lines 59-62); and

delivering the digital content to the unit (e.g., transmitting the video programming to the terminal 15), the delivery of the digital content being independent of an asynchronous delivery of a second digital content to a second unit in the multiple unit environment (for example, one customer requests a first video programming, other customer request a second video programming at different time. Thus, the system delivers the first video programming and the second video programming to the customers independently - see col. 9, line 39 to col. 10, line 7).

Regarding claim 51, it is noted that the system of Budow is provided with programs or software, which are necessary to make the system executes the function to implement the method of claim 34 (see col. 10, lines 19-25).

Regarding claim 2, Budow discloses that the video server 12 stores many movies that are simultaneously accessible to hundreds of viewers. Budow further discloses that the system 9 can be configured so that only one customer or multiple customers can access a particular video on demand program stored in the server 12 at a given time (see col. 9, lines 39-42, 54-57;

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col. 10, lines 4-6; col. 7, lines 1-5).

Regarding claim 3, Budow discloses providing simultaneous asynchronous delivery includes software designed to read the digital content from the memory on the server and transmit the digital content to the unit (see col. 9, lines 22-28; col. 10, lines 19-24).

Regarding claim 4, Budow discloses controls for pausing the digital content (see col. 4, lines 48-52; col. 12, lines 42-45).

Regarding claim 5, Budow discloses controls for randomly accessing the digital content (randomly request the service, e.g. pay per view or video on demand from the viewers) (see col. 7, lines 39-42).

Regarding claim 6, Budow discloses that the digital content includes content available on an internetwork (internal video distribution network -see col. 4, lines 30-35).

Regarding claim 7, Budow discloses that the digital content includes video (see col. 6, lines 45-65).

Regarding claim 8, Budow discloses that a set-top box (the terminal 15 comprises a set top box) designed to enable access to the digital content, the set-top box coupled to the server and to a display (16) in the unit (see figure 2).

Regarding claim 9, Budow discloses that the set-top box is coupled to the server via a switching hub for a network, the switching hub designed to allow a plurality of units to access the server (see col. 7, lines 11-23).

Regarding claim 10, Budow discloses that the set-top box is designed to allow access to a non-digital content (RF format) displayed on the display (see col. 7, lines 5-7).

Regarding claim 11, Budow discloses that the set-top box includes a handset (17) (see figure 2).

Regarding claim 12, it is noted that the server includes content metadata about the

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digital content stored in the memory of the server. For instance, Budow discloses that the server 12 includes information about the programming stored in the memory so that when it receives commands from the control computer 13, the server 12 selects a requested programming to transmit to the appropriate room terminal (see col. 9-10, lines 65-1).

Regarding claims **19, 20, 43, 44 and 50**, Budow discloses that the systems control computer 13 monitors the room terminals in order to determine which customers access the programming and should be billed for the services (see col. 10, lines 15-17, 45-47; col. 12, lines 5-10). Budow further discloses that the systems control computer 13 can use an internal database information to determine what type of programming the customer prefers and then transmit advertisements for similar programming to the customer (see col. 14, lines 2-5).

Regarding claim **32**, Budow discloses that a second server (11) offsite from the multiple unit environment, the second server coupled to the server to provide digital content to the server (see figure 2).

Regarding claims **24, 33 and 47**, Budow discloses that the systems control computer 13 can selectively insert commercials based on the viewing habits of each particular customer or customer's interests. It must be understood that the systems includes a user profile updater designed to update user profile (see col. 13, lines 29-45).

Regarding claims **27 and 28**, Budow discloses that if the advertisement is stored within a memory of the video server 12, the systems control computer 13 transmits appropriate signals to the video server 12, identifying the advertisement to be transmitted. The customer receives the advertisement transmitted by the systems control computer 13 rather than the one transmitted by the cable television station (see col. 13, lines 11-21).

Regarding claim **35**, Budow discloses that the digital content includes content available on an internetwork (internal video distribution network -see col. 4, lines 30-35).

Regarding claim **36**, Budown discloses delivering the digital content includes delivering video (video programming) to the unit 15 (see col. 9, line 65 to col. 10, line 1).

Regarding claim **37**, Budow discloses receiving a request includes receiving a request for the digital content from a set-top box (15) in the unit (see col. 7, lines 25-45).

Regarding claim **49**, Budow discloses sending the digital content from a second server (11) to the server for storage until requested by the unit (see col. 6, lines 45-51).

Regarding claims **55-86**, Budow discloses that customers can utilize playback commands such as pause, fast forward, resume, rewind...etc, via remote control or handset 17. That is, the infrared signals generated by the remote control 17 are transmitted to the TV 16, which transmits the signals to the data processor 401. These signals are transmitted to the system control computer 13. The system control computer 13 processes the request and issues commands to the video server 12 (see col. 11-12, lines 61-2). Customers can use the remote control 17 to implement a bookmark application. This application allows customers to stop the transmission of a selected video program (i.e., pausing the video program) and begin watching the program from the exact same point at a later time (i.e., resuming the video program). The room terminal from the customer transmits the signal for the bookmark application via the video distribution network 14 to the system control computer 13. The computer 13 also transmits commands to the video server 12 to cease transmission of the program to mark in its memory the stopping place. The customer can reactivate transmission of the programming (i.e., resuming the program) with the remote control 17. The room terminal 15 transmits the command to the system control computer 13 via the video distribution network 14. The systems control computer 13 receives the transmission and forwards the appropriate data to the video server 12 to reactivate transmission of the program from the location of the bookmark (see col. 4, lines 47-58; col. 11, lines 59-62; col. 12, lines 26-61).

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3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 52-54 are rejected under 35 U.S.C. 102(e) as being anticipated by Shintani et al. (US 20020124249 A1).

Regarding claim **52**, Shintani discloses a method for delivering digital content from a second server (66 & 56) to a first server (12) for storage, the method comprising:

receiving a request from the first server for access to a user profile stored in a memory (68) on the second server (the system 10 queries the user profile database 68 of user profile server 66 to obtain profile information relating to the user – see page 5, 0047);

accessing user metadata (profile parameters) about the user profile; selecting digital content (advertisements) that satisfies the user metadata (the profile information is then used by the advertising server 56 along with the history information, time of day, data, advertisement history and VOD section to correlate to advertisements stored in the advertisement database 58 that appropriately target the user – page 5, 0044 and 0047); and

sending the digital content to the first server from the second server for storage (sending the advertisements from advertisement server 56 to media server 12 for later inserting the advertisements with other content to deliver to the user – see page 5, 0048).

Regarding claim **53**, Shintani discloses receiving a request includes receiving a request for access to a plurality of user profiles stored in the memory of the second server (68); accessing user metadata includes accessing user metadata about each user profile (profile



parameters); and selecting digital content (advertisements) includes selecting digital content that satisfies the user metadata about at least a subset of the user profiles (the profile information is then used by the advertising server 56 along with the history information, time of day, data, advertisement history and VOD section to correlate to advertisements stored in the advertisement database 58 that appropriately target the user – page 5, 0044, 0047 and figure 1).

Regarding claim **54**, it is noted that the system of Shintani is provided with programs or software, which are necessary to make the system executes the function to implement the method of claim 52 (see page 7, 0057).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 16, 17, 23, 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Budow et al. (US 5,521,631 A).

Regarding claims **16 and 17**, Budow discloses the digital content includes video and video game (see col. 4, lines 48-52 and abstract). Budow fails to disclose rating for the video and the game. Official Notice is taken that rating for the video or game based on the content, e.g., R, PG-13 is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art to modify Budow by including content rating for the video or game in order to effectively determine the suitable programming for viewing.

Regarding claims **23 and 46**, Budow discloses that the computer 13 processes billing services (see col. 10, lines 44-47; col. 13, lines 35-38). Budow does not specifically disclose the

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billing including discount rate. Official Notice is taken that providing discount rate for a product or service to customers is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Budown by including discount rate for ordering video programming requested by customers for business purposes.

7. Claims 13-15, 18, 21, 22, 25, 26, 29-31, 38-42, 45, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Budow et al. (US 5,521,631 A) in view of Sezan et al. (US 20040261095 A1).

Regarding claims **13-15, 18, 21, 22, 25, 26, 29-31, 38-42, 45 and 48**, Budow discloses accessing the digital content based on the user's request, for example, pay per view or video on demand (see col. 7, lines 39-44). Budow also discloses that the system control computer 13 can use an internal data based information to determine what type of programming the customer prefers and then transmit advertisements for similar programming to the customer. The system control computer 13 determines programming such as commercials based on the customer's interests or viewing habits of each particular customer (see col. 13, lines 29-50; col. 14, lines 1-16). The computer 13 also provides billing services (see col. 10, lines 15-17 and 44-47). Budow does not specifically disclose providing a programming content satisfies a particular user profile and/or storing user profile at a server. However, Sezan discloses that the system selects an appropriate content for a particular user based upon the user preference, wherein the user preference includes information regarding particular programs and categorization of programs that the user prefers to view (see 0046, 0185, 0199, 0207). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Budow by selecting a programming content based on a particular user preference as taught by Sezan in order to provide appropriate content for a particular user for viewing.

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### **Conclusion**

8. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

### **Certificate of Mailing**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

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I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (703) \_\_\_\_\_ - \_\_\_\_\_ on \_\_\_\_\_  
(Date)

Typed or printed name of person signing this certificate: \_\_\_\_\_

Signature: \_\_\_\_\_

Registration Number: \_\_\_\_\_

Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ngoc K. Vu whose telephone number is 571-272-7306. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on 571-272-7294. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ngoc K. Vu  
Primary Examiner  
Art Unit 2611

April 15, 2005